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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,112	06/19/2002	Masayuki Hatanaka	020231	3705

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT PAPER NUMBER

2136

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,112

Applicant(s)

HATANAKA ET AL.

Examiner

Pramila Parthasarathy

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>5/28/2006</u> |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on March 16, 2006. Claims 1– 46 were previously presented. No new claims were added. Claim 46 was cancelled. Claims 1 – 45 were amended. In view of Examiner initiated interview (see Examiner initiated interview, May 23, 2006), Claims 1 – 45 are currently pending.

Response to Arguments

2. Applicant's arguments filed on March 16, 2006 have been fully considered.

3. Applicant's arguments, with respect to 35 USC 103 rejection have been fully considered and are persuasive. The 35 USC 103 of Claims 1 – 45 has been withdrawn.

4. With respect to Double patenting rejection with copending application, Examiner corrects the typographical mistake while identifying the copending application and hereby maintains the rejection with copending application 10/129950.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 – 45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended claims 30 - 53 of copending Application No. 10/129,950. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A partial correspondence between the instant claims and the copending claims are as follows:

10/069,112	10/129,950
1	30 – 37
2	38
3	39
4	37
5, 6	40 – 41

10/069112	10/129,950
a license key for decrypting encrypted content data	a first key unique to ... decryption information data from outside
a first interface unit for externally transmitting data;	an interface ... for transmitting data
a first session key generating unit for producing a first symmetric key to be updated in response to every transmission of said license key;	a first session key generating portion for producing a first symmetric key to be updated upon every distribution of said decryption information data;
a session key encryption processing unit	a session key encryption processing portion
a session key decrypting unit for decrypting	a session key decryption processing portion
a first license data encryption processing unit	first encrypting and communicating means
a second license data encrypting for further encrypting the output of said first license data encryption processing unit and a second interface	a send/receive portion for externally transmitting the data over said information transmission network; and second encrypting

unit for externally transmitting the data	and communication means for receiving said first key ...and sending the encrypted decryption information data.
a data storing unit for receiving and storing at least said license key from content supply device;	first storing means for storing said encrypted content data and said plain-text additional information data
a first public encryption key is predetermined for said data storing unit and said data storing unit includes a first key holding portion for holding a first public encryption key for externally output	a first key holding portion for holding said first public encryption key for externally output,
a first decryption processing unit for receiving and decrypting said first symmetric key encrypted with said first public encryption key	a first decryption processing portion for receiving and decrypting said first symmetric key encrypted with said first public encryption key
a second key holding unit for holding said second public key encryption key	a second key holding portion for holding said second public encryption key
a second session key generating unit for producing said second symmetric key	a second session key generating portion for producing said second symmetric key
a first encryption processing unit for encrypting said public encryption key and said second symmetric key based on said first symmetric key, and outputting the encrypted key to said second interface unit	a first encryption processing portion for encrypting said second public encryption key and said second symmetric key and applied from said second decryption information data; encryption processing portion
a second decryption processing unit for receiving said license key encrypted with said second	a second decryption processing portion for receiving said decryption information data

symmetric key further encrypted with said second public encryption key and applied from said second license data encryption processing unit, and decrypting the received license key based on said second symmetric key	encrypted with said encrypted second public encryption key, further encrypted with second symmetric key and applied from said decryption information data encryption processing portion
a third key holding unit for holding a second private decryption key used for decrypting the data encrypted with said second public encryption key and being unique to said data storing unit	a fourth key holding portion for holding the second private decryption key for decrypting the data encrypted with said second public encryption key
a third decryption processing unit for receiving said license key encrypted with said second public encryption key, and decrypting the received license key with said second private decryption key	a third decryption processing portion for decrypting said decryption information data encrypted with said second public encryption key with said second private decryption key
a memory unit for storing and encrypted content data and said license key	wherein said data storing portion is a memory card; said third decryption processing portion decrypts said encrypted decryption information data read from said storing means

Georgia-Pacific Corp. v. United States Gypsum Co., 195 F.3d 1322, 1326, 52

USPQ2d 1590, 1593 (Fed. Cir. 1999). Second, the court determines whether the differences in subject matter between the two claims render the claims patentably distinct. Id. at 1327, 52 USPQ2d at 1595. A later claim that is not patentably distinct from an earlier claim in a commonly owned patent is invalid for obvious-type double

patenting. In re Berg, 140 F.3d 1428, 1431, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998).

A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP 804.

Conclusion

Allowable Subject Matter

Claims 1 – 45 are allowable over prior art.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


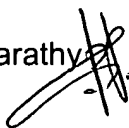
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-232-3795. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

May 28, 2006.



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
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